

1626

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of ) Examiner: Shameem, G. M.  
John E. T. Corrie et al. ) Art Unit: 1626  
Serial No.: 09/936,975 )  
Filed: December 27, 2001 ) Attorney reference No:  
For: "1-ACYL-7-NITROINDOLINE ) 0380-P02671US0  
DERIVATIVES, THEIR )  
PREPARATION AND THEIR USE) AS PHOTOCLEAVABLE )  
PRECURSORS" )

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited on the date identified below with the United States Postal Service as first class mail in an envelope properly addressed to COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.

January 14, 2004  
Date

Lyn C. Fischer  
Lyn C. Fischer

Mail Stop:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESUBMISSION OF LITERATURE REFERENCES  
INDICATED AS MISSING FROM INFORMATION  
DISCLOSURE STATEMENT SUBMITTED JUNE 21, 2002  
AND REQUEST UNDER 37 C.F.R. §1.8 THAT SUCH  
MISSING REFERENCES BE CONSIDERED FILED AS OF JUNE 21, 2002.**

An Information Disclosure Statement for the above-referenced application, together with copies of all the listed references, were submitted to the Patent Office along with a certificate of mailing in accordance with 37 CFR §1.8(a) on June 21, 2002. Examiner Shameem noted on Patent and Trademark

Office Form 1449 that all non-patent references were missing. Applicants hereby request, for the reasons presented below, that the references indicated as missing by Examiner Shameem be treated as submitted as of June 21, 2002, and be duly considered and made of record in the present application.

In accordance with 37 CFR §1.8(b)(2), Applicants are resubmitting herewith replacement copies of the missing references, along with a copy of the Information Disclosure Statement as submitted to the Patent and Trademark Office on June 21, 2002.

Applicants are also submitting a copy of the postcard receipt attached to the Information Disclosure Statement filed June 21, 2002, indicating that copies of the references were enclosed. The postcard has a date-in stamp of June 26, 2002, acknowledging that all materials had been received.

Included among the materials forwarded to the Patent Office were copies of U.S. patents, an international patent application, and literature references. All the documents were submitted concurrently, and since the Patent and Trademark Office acknowledges receipt of the U.S. and international patent documents, it is assumed that the literature references were also received. The only explanation that Applicants can offer for why the literature references have gone missing is that they must have been

misplaced by the Patent and Trademark Office after receipt.

Applicants believe that no fee is required for the resubmission of these literature references, as this appears to have been a mistake on the part of the Patent and Trademark Office. In the event a fee is required in connection with this matter, the Commissioner is hereby authorized to charge such a fee to Deposit Account No. 04-1406. A duplicate copy of this paper is enclosed.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN  
A Professional Corporation

By Patrick J. Hagan  
Patrick J. Hagan  
PTO Registration No. 27, 643

Telephone: (215) 563-4100

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The following papers have been received

In re Application of  
JOHN CORRIE ET AL.

Appl. No.  
09/936,975

Attorney Docket No.  
0380-P02671US0

For: 1-Acyl-7-Nitroindoline  
Derivatives, Their  
Preparation And Their Use  
As Photocleavable  
Precursors

IDS w/PTO-1449  
\$1.8 Cert. Of Mailing  
Copies of Cited Refs.  
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Patent and Trademark Office is respectfully requested to place its STAMP on this POSTAL CARD and place it in the outgoing mail.

Mailed: 21 June 2002

By: Patrick J. Hagan, Esq. (jmn)

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**JAN 16 2004**  
**PATENT & TRADEMARK OFFICE**

JOHN CORRIE et al.

09/936,975

0380-P02671US0

December 27, 2001

# 1-ACYL-7-NITROINDOLINE DERIVATIVES, THEIR PREPARATION AND THEIR USE AS PHOTOCLEAVABLE PRECURSORS

Not Yet Assigned

1635

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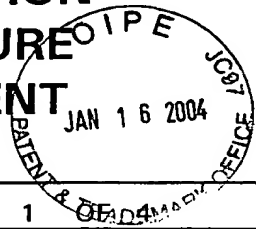
Patrick J. Hagan  
Patrick J. Hagan

## INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97

In the event that a fee is required, the Commissioner is authorized to charge Deposit Account No. 04-1406 of the undersigned attorneys. A duplicate copy of this sheet is enclosed.

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# INFORMATION DISCLOSURE STATEMENT



SHEET 1

*Complete if known*

Application Number: 09/936,975

Filing Date: December 27, 2001

First Named Inventor: JOHN CORRIE et al.

Group Art Unit: 1635

Examiner Name: Not Yet Assigned

Attorney Docket Number: 0380-P02671US0

## UNITED STATES PATENT DOCUMENTS

| EXAMINER'S INITIALS | CITE NO. | PATENT NUMBER | ISSUE DATE<br>MM-DD-YYYY | FIRST NAMED INVENTOR      |
|---------------------|----------|---------------|--------------------------|---------------------------|
|                     | A1       | 4,210,590     | 07/01/1980               | Bruce E. Maryanoff et al. |
|                     | A2       | 6,268,389 B1  | 07/31/2001               | Franz Esser et al.        |

## FOREIGN PATENT DOCUMENTS

| EXAMINER'S INITIALS | CITE NO. | DOCUMENT NUMBER | COUNTRY OR REGION | DATE OF PUBLICATION<br>MM-DD-YYYY | FIRST NAMED INVENTOR OR APPLICANT  |
|---------------------|----------|-----------------|-------------------|-----------------------------------|------------------------------------|
|                     | B1       | WO 86/00527     | WO                | 01/30/1986                        | DANA-FARBER CANCER INSTITUTE, INC. |

## OTHER PRIOR ART - NON-PATENT DOCUMENTS

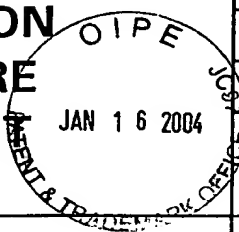
| EXAMINER'S INITIALS | CITE NO. | Include name of the author (in Capital Letters), title of the article (when appropriate), title of the item(book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published |
|---------------------|----------|---|
|                     | C1       | GOISSIS, G. et al., "Synthesis of Protected Peptide Acids and Esters by Photosolvolysis of 1-peptidyl-5-bromo-7-nitroindolines"; Proc. Am. Peptide Symp., 5: 559-61 (1977)  |
|                     | C2       | Yeda Research and Development Co., Ltd., "Reversible blocking of acyl groups during organic synthesis using 7-nitroindoline derivatives as blocking agents"; Chem. Abstracts, Ab. No. 181004x, 92(21): 637 (1980)   |
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EXAMINER'S  
SIGNATURE

DATE  
CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP §609. Draw a line through citation if citation not in conformance and reference not considered. Include a copy of this form with next communication to applicant.

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Examiner Name: Not Yet Assigned

SHEET 2 OF 4

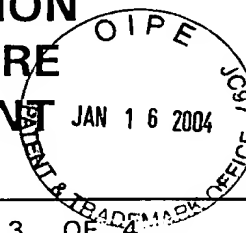
Attorney Docket Number: 0380-P02671US0

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| C9  | PAPAGEORGIOU, G. et al., "Synthetic and Photochemical Studies of <i>N</i> -Arenesulfonyl Amino Acids"; Tetrahedron 55: 237-254 (1999)   |
| C10 | GIVENS, R.S. et al., "New Photoactivated Protecting Groups. 7. <i>p</i> -Hydroxyphenacyl: A Phototrigger for Excitatory Amino Acids and Peptides"; J. Am. Chem. Soc. 119: 8369-8370 (1997)  |
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| C17 | GALL, W.G. et al., "Synthesis of 7-Substituted Indoline Derivatives"; J. Org. Chem. 20: 1538-1544 (1955)  |
| C18 | ZUMAN, P. et al., "Addition, Reduction, and Oxidation Reactions of Nitrosobenzene"; Chem. Rev., 94: 1621-1641 (1994)  |
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Attorney Docket Number: 0380-P02671US0

SHEET 3 OF 4

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| C24 | KAPLAN, J.H. et al., "Rapid Photolytic Release of Adenosine 5'-Triphosphate from a Protected Analogue: Utilization by the Na:K Pump of Human Red Blood Cell Ghosts"; Biochemistry, 17(10): 1929-1935 (1978)   |
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| C27 | KHODAKHAH, K. et al., "Fast activation and inactivation of inositol trisphosphate-evoked Ca <sup>2+</sup> release in rat cerebellar Purkinje neurones"; J. Physiol., 487.2: 343-358 (1995)  |
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| C31 | CORRIE, J.E.T. et al. "Synthesis and Absolute Stereochemistry of the Two Diastereoisomers of P <sup>3</sup> -1-(2-Nitrophenyl)ethyl Adenosine Triphosphate ('Caged' ATP)"; J. Chem. Soc. Perkin Trans. I, 1015-1019 (1992)  |
| C32 | KAWASE, M. et al., "Silica Gel Assisted Reductive Cyclization of 2-Nitro- $\alpha$ -piperidinostyrenes, Derived from 2-Nitrotoluenes, to Indoles"; J. Heterocyclic Chem., 24: 1499-1501 (1987)  |
| C33 | BUCHANAN, J.G. et al., "Synthesis of the Indole Nucleoside Antibiotics Neosidomycin and SF-2140"; J. Chem. Soc. Perkin Trans. I, 1417-1426 (1994)   |
| C34 | GANGJEE, A. et al., "Synthesis and Biological Evaluation of Nonclassical 2,4-Diamino-5-methylpyrido[2,3-d]pyrimidines with Novel Side Chain Substituents as Potential Inhibitors of Dihydrofolate Reductases"; J. Med. Chem., 40: 479-485 (1997)  |
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**INFORMATION  
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SHEET 4

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Filing Date: December 27, 2001

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Group Art Unit: 1635

Examiner Name: Not Yet Assigned

Attorney Docket Number: 0380-P02671US0

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|  | C36 | KRUSE, L.I., "Synthesis of 4-Substituted Indoles from o-Nitrotoluenes"; Heterocycles, 16(7): 1119-1124 (1981)  |
|  | C37 | CORRIE, J.E.T. et al., "Synthesis and evaluation of photolabile sulfonamides as potential reagents for rapid photorelease of neuroactive amines"; J. Chem. Soc., Perkin Trans. I, 1583-1592 (1996) |
|  | C38 | PAPAGEORGIOU, G. et al., "Effects of Aromatic Substituents on the Photocleavage of 1-Acyl-7-nitroindolines"; Tetrahedron 56: 8197-8205 (2000)  |

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most pertinent of which the undersigned is aware. However, no representation is made or intended that more pertinent references do not exist.

This submission is not an admission that the references listed on the attached Form PTO-1449 constitute prior art against the claims of this application.

The Examiner is respectfully requested to confirm receipt and consideration of the cited references by initialing and returning a copy of the attached Form PTO-1449 in accordance with MPEP §609.

Early and favorable consideration of this application is respectfully requested.

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN  
A Professional Corporation  
Attorneys for Applicant(s)

By Patrick J. Hagan  
Patrick J. Hagan  
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Enclosures - Form PTO-1449

Copies of references listed on PTO - 1449